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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/103,287 06/23/98 BURNHAM

M GM10025

EXAMINER

HM22/1216

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ART UNIT

PAPER NUMBER

1633

DATE MAILED:

12/16/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/103,287**

Applicant(s)  
**Burnham et al**

Examiner  
**James Martinell**

Group Art Unit  
**1633**



☒ Responsive to communication(s) filed on Nov 23, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 16-43 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 16-43 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The amendment filed November 243, 1999 has been entered.

The instant application does not conform to the Sequence Rules (37 CFR §§1.821 - 1.825). The instant application was filed after the effective date for the revised Sequences Rules (June 1, 1998). Applicant must submit a new sequence listing that conforms with the revised rules in order for the response to this Office action to be complete. See also MPEP 2420-2431.

Claims 22-25 and 35-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague and indefinite.

- (a) The recitation of "consisting of an amino acid sequence of SEQ ID NO" (claims 22 and 35) is vague and indefinite because it is not clear whether the nucleic acids mentioned in the claims encode the entire amino acid sequences referred to in the claims or only a small part of each of the amino acid sequences mentioned in the claims.

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Claims 18-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. One of skill in the art would not be able to make and/or use the claimed invention for the following reasons.

- (a) The instant application does not teach those of skill in the art how to isolate any of the polypeptides mentioned in the claims. It is well known that polypeptide extraction and isolation are empirical in nature (see Critical Synergy: The Biotechnology Industry and Intellectual Property Protection, BIO (October 17, 1994)). Thus, the application does not enable those of skill in the art to isolate any of the polypeptides mentioned in the claims. As the isolation of the polypeptides is not enabled, so too the use of any polynucleotide that encodes any of the polypeptides

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is not enabled. Likewise, the instant application does not teach how to use the vectors and host cells that contain the polynucleotides that encode the polypeptides mentioned in the claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-24 and 35-37 are rejected under 35 U.S.C. 102 (a) or (b) as being clearly anticipated by either one of Kunsch et al (EP 0 786 519 (July 30, 1997)) or Varon et al (Mol. Microbiol. 20: 339 (1996)). The references disclose DNAs that encode portions of sequences contained in SEQ ID NOs 2 and 4 and thus meet the claims. Since sequences were determined in each of the

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references, the DNAs of the references were necessarily contained in cloning vectors and host cells.

Certain papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1633 at (703) 308-4242. The faxing of such papers must conform with the rules published in the Official Gazette, 1156 OG 61 (November 16, 1993).

Any inquiry concerning this communication should be directed to J. Martinell at telephone number (703) 308-0296.

  
JAMES MARTINELL, Ph.D.  
SENIOR LEVEL EXAMINER